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CUSTOMER NUMBER 27792

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Craig Ranta Attorney Docket No: MICR0230
Serial No: 09/476,291 Group Art Unit: 2611
Filed: December 30, 1999 Examiner: Chung, Jason J.
Title: METHOD AND SYSTEM FOR DOWNLOADING, STORING AND
DISPLAYING COUPON DATA USING THE HORIZONTAL OVERSCAN
PORTION OF A VIDEO SIGNAL

APPEAL BRIEF TRANSMITTAL LETTER

Bellevue, Washington 98004

June 8, 2005

TO THE COMMISSIONER FOR PATENTS:

Enclosed herewith for filing in the above-identified patent application is an Appeal Brief in triplicate. Also enclosed is our check No. 8276 in the amount of \$500. Please charge any additional fees or credit any overpayment to Deposit Account No. 01-1940. A copy of this sheet is enclosed.

Respectfully submitted,

Michael C. King
Registration No. 44,832

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on June 8, 2005.

Date: June 8, 2005



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TO THE DIRECTOR OF THE PATENT AND TRADEMARK OFFICE:

TABLE OF CONTENTS

REAL PARTY OF INTEREST	2
RELATED APPEALS AND INTERFERENCES.....	2
STATUS OF THE CLAIMS	2
STATUS OF THE AMENDMENTS	2
SUMMARY OF THE INVENTION	2
ISSUES PRESENTED FOR REVIEW	4
GROUPING OF CLAIMS.....	4
ARGUMENT.....	4
Rejection of Claims 1-25, 27, 29 and 31 under 35 U.S.C. § 103(a).....	4
Rejection of Claims 2, 24, 25 and 28 under 35 U.S.C. § 103	10
Rejection of Claims 9, 19, 29 and 31 under 35 U.S.C. § 103.....	12
CONCLUSION.....	15
APPENDIX.....	17
Claims on Appeal:	17

This is an appeal from a final rejection by Examiner Jason Chung of Group Art Unit 2611. A Final Rejection was mailed on November 18, 2004. Appellant filed a Notice of Appeal on April 8, 2005 and paid for a two month extension of time to reply to the Office Action at that time.

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LAW OFFICES OF RONALD M. ANDERSON
600 - 108th Avenue N.E., Suite 507
Bellevue, Washington 98004
Telephone: (425) 688-8816 Fax: (425) 646-6314

1 The jurisdiction of this board is invoked under the provisions of 35 U.S.C. § 134 and 37
2 C.F.R. §§ 1.191-192.

3 REAL PARTY OF INTEREST

4 The real party of interest in this appeal is hereby identified as Microsoft Corporation, since
5 all right and title in the invention and in the patent application on appeal has been assigned to
6 Microsoft Corporation, as evidenced by a chain of title from the inventors of the patent application
7 identified above to the current assignee, as shown below:

8 From inventor **Craig Ranta** (assignment executed March 20, 2000) to **Microsoft**
9 **Corporation**. The assignment was recorded in the Patent and Trademark Office on April 10, 2000
10 at Reel 010679, Frame(s) 0654.

11 RELATED APPEALS AND INTERFERENCES

12 No other appeals or interferences are known to appellant, appellant's undersigned legal
13 representative, or by the assignee of this application that will directly affect or be directly affected by
14 or have a bearing on the Board's decision in this pending appeal.

15 STATUS OF THE CLAIMS

16 Claims 1-25, 27-29, and 31 remain pending in the application on appeal, Claims 26 and 30
17 having been previously cancelled. Appellant appeals the final rejection of each pending claim.

18 STATUS OF THE AMENDMENTS

19 No amendment has been filed subsequent to the mailing of the Final Office Action.

20 SUMMARY OF THE INVENTION

21 The present invention is directed to an electronic coupon created using a portable computing
22 device configured to receive electronic coupon data that have been extracted from the horizontal
23 overscan portion of a video signal. Advertisers can encode electronic coupon data for transmission
24 with a video signal. For example, an advertiser for tires might encode coupon data in the video
25 signal of a commercial for tires, so that the coupon data are employed to produce an electronic
26 coupon that can be redeemed for a discount when purchasing tires in a retail establishment.

27 The electronic coupon includes a display (preferably an LCD screen) so that coupon data can
28 be viewed. \n one embodiment, the electronic coupon is configured to display a bar code that can be
29 scanned at a retail establishment to redeem the coupon. The electronic coupon further includes a
30 processor and a memory. Machine instructions are stored in the memory and are executed by the
31 processor. The machine instructions control the operational characteristics of the electronic coupon.

1 The electronic coupon also includes a receiver that receives the coupon data. In one embodiment, an
2 external decoder receives an encoded video signal (i.e., a video signal into which coupon data have
3 been encoded in the horizontal overscan portion thereof), and extracts the coupon data from the
4 encoded video signal. The decoder then transmits the extracted coupon data to the electronic
5 coupon. In another embodiment, the decoder is integrated into the electronic coupon, such that the
6 receiver in the electronic coupon is configured to receive the encoded video signal, and the
7 electronic coupon itself extracts the encoded coupon data from the horizontal overscan portion of the
8 video signal.

9 To achieve a simple device, the electronic coupon preferably includes only a limited number
10 of controls. In one preferred embodiment, the electronic coupon includes a mode key, a select key,
11 an up key, and a down key. The mode key enables the user to toggle between a set-up mode, a
12 storage mode, and a redeem mode (specification, page 8, lines 2-11) as they are sequentially
13 displayed on the LCD screen. The up and down keys are used to navigate through lists. Two types
14 of lists are displayed to the user of the electronic coupon, including a list in the set-up mode and a
15 list in the redeem mode.

16 The set-up mode displays a menu (i.e., a list) of products or services, such that the user can
17 control the types of coupons that will be stored in the electronic coupon by selecting products or
18 services from the displayed menu. Significantly, only coupons corresponding to the products or
19 services selected during the set-up mode will be stored in the electronic coupon.

20 The storage mode enables the electronic coupon to process incoming data (extracted coupon
21 data or an encoded video signal, where the decoder is part of the electronic coupon), so that only
22 coupons corresponding to products or services selected during the set-up mode are stored in the
23 electronic coupon. All other coupon data (i.e., coupon data not corresponding to products or
24 services selected during the set-up mode) are discarded (page 9, lines 3-5). This approach
25 overcomes a problem characteristic of many small portable computing devices; limited memory
26 resources. When the memory is full, such that no additional coupons can be taught stored, a warning
27 message is displayed to the user.

28 The redeem mode enables a specific electronic coupon to be redeemed (by displaying the
29 coupon data, such as a bar code), or deleted. In the redeem mode, the list displayed is a list of all
30 those coupons that have been received and stored (i.e., all those coupons not discarded). The user
31 can scroll through the list and select a specific coupon. When the electronic coupon is placed in the
~ ~

1 redeem mode, the selected coupon will be displayed for redemption. Saved coupons can also be
2 selected from the list for deletion from the memory (page 10, lines 5-12).

3 ISSUES PRESENTED FOR REVIEW

4 1. A determination as to whether Claims 1-25, 27-29, and 31 are patentable under
5 35 U.S.C. § 103(a) over Mankovitz et al. (U.S. Patent No. 5,523,794) in view of Small (U.S. Patent
6 No. 5,808,689), further in view of Terrill et al. (U.S. Patent No. 6,052,755), further in view of
7 Levitan (U.S. Patent No. 5,534,911), and further in view of Williams et al. (U.S. Patent No.
8 6,075,971).

9 GROUPING OF CLAIMS

10 In regard to the rejection of the claims as unpatentable under 35 U.S.C. § 103(a) over
11 Mankovitz et al. (U.S. Patent No. 5,523,794) in view of Small (U.S. Patent No. 5,808,689), further in
12 view of Terrill et al. (U.S. Patent No. 6,052,755), further in view of Levitan (U.S. Patent No.
13 5,534,911), and further in view of Williams et al. (U.S. Patent No. 6,075,971), the claims do not all
14 stand or fall together. Claims 1-25, 27, 29, and 31 must be analyzed with respect to whether the
15 cited art teaches or suggests a menu of products and services displayed in a set-up mode to enable a
16 user to control the types of coupons stored by the electronic coupon. Claims 2, 24, 25 and 28 must
17 be analyzed with respect to whether the cited art teaches or suggests an electronic coupon
18 comprising an integral decoder configured to extract coupon data from the horizontal overscan
19 portion of the video signal. And, Claims 9, 19, 29, and 31 must be analyzed with respect to
20 whether the cited art teaches or suggests an electronic coupon requiring a keystroke to place the
21 electronic coupon in a storage mode. The rejection based on Mankovitz in view of Small, further
22 in view of Terrill, Levitan and Williams, thus will require three distinct and different analyses
23 relative to the combination of references cited.

24 ARGUMENT

25 Rejection of Claims 1-25, 27, 29, and 31 under 35 U.S.C. § 103(a)

26 The Examiner has rejected Claims 1-25, 27, 29, and as being obvious over Mankovitz et al.
27 (U.S. Patent No. 5,523,794), in view of Small (U.S. Patent No. 5,808,689), further in view of Terrill
28 et al. (U.S. Patent No. 6,052,755), further in view of Levitan (U.S. Patent No. 5,534,911), and
29 further in view of Williams et al. (U.S. Patent No. 6,075,971). The Examiner asserts that:
30 (1) Mankovitz discloses an electronic coupon on extracting data from the vertical blanking interval
31 of a video signal; (2) Small discloses extracting data from the horizontal overscan portion of a video
32

1 signal; (3) Terrill discloses the interchangeability of RAM and ROM; (4) Levitan discloses a
2 personal channel menu a user can use to select entertainment programming; and, (5) Williams
3 discloses delivering coupons to a user based on a personal preference profile (which can encompass
4 programming, products, activities or services enjoyed by the user). The Examiner concludes that an
5 artisan of ordinary skill would have been led to combine and modify these references in order to
6 provide a system and method for distributing coupons. Appellant respectfully disagrees for the
7 following reasons.

8 Levitan discloses an entertainment network that generates a customer profile relating to a
9 particular customer's viewing preferences. Broadcast content is analyzed to determine how well a
10 particular program correlates to a customer's profile. When that customer is interested in viewing
11 program content, the customer can access their personal channel menu, and review programming
12 content selected by the entertainment network as corresponding to the customer profile. The
13 customer can then select a particular program to view. This approach is asserted to be convenient
14 for the customer, because instead of having to surf through many different channels looking for
15 content that may interest them, the customer is presented with a relatively small targeted list of
16 content. The Examiner specifically states that "It would have been obvious to one of ordinary skill
17 in the art the time the invention was made to modify Mankovitz in view of Small further in view of
18 Terrill to have a plurality of control keys bring up the menu so the user can select their desires as
19 taught by Levitan in order to enable the user to have an active part of what content they are
20 presented" (Office Action dated November 18, 2004, page 6, third paragraph).

21 It appears the Examiner is arguing that it would have been obvious to modify Mankovitz's
22 electronic coupon to include a menu that enabled a user to select content. The Examiner
23 acknowledges that Mankovitz fails to teach selecting a product or service, but asserts that Williams
24 discloses that a preference profile can be used to enable an entertainment network to deliver coupons
25 to specific users who have an observed or disclosed to preference for a particular service or product.
26 The Examiner concludes that further modifying Mankovitz's electronic coupon in view of this
27 teaching of Williams would achieve an equivalent to what appellant is claiming.

28 Appellant disagrees with the Examiner's conclusion that the above-noted combination of
29 references would achieve an equivalent invention. Appellant recognizes that Williams discloses a
30 technique for targeting the types of coupons that will be sent to (or stored by) a member of the
31 entertainment network, so that members of the entertainment network are likely to receive coupons
32

1 that correspond to their personal interests and are less likely to receive coupons that do not
2 correspond to their personal interests. The electronic coupon disclosed by Mankovitz does not
3 include any type of coupon filtering paradigm. Thus, any coupon data included in the vertical
4 blanking interval of video signal will be stored in Mankovitz's electronic coupon. Ignoring for the
5 moment the issue of whether sufficient motivation exists that would lead one of ordinary skill in this
6 art to modify Mankovitz in view of Williams (or any of the other cited art required to achieve an
7 equivalent invention), even if the electronic coupon disclosed by Mankovitz were modified to
8 incorporate the coupon filtering paradigm disclosed by Williams, the result would not be equivalent
9 to appellant's claims, because the coupon filtering paradigm disclosed by Williams is different than
10 the coupon filtering paradigm employed in the electronic coupon defined by appellant's claims.

11 Appellant's independent Claims 1, 13, 24, 27, 29, and 31 each recite the common element
12 (recited either as a step or as a function implemented by a processor) of a *set-up mode that displays a*
13 *menu of products or services to a user, enabling the user to control what coupons will be stored in*
14 *the electronic coupon, by selecting **specific products or services** from the displayed menu.* The core
15 issue with respect to this rejection is to determine whether the cited art teaches or suggests an
16 equivalent to this feature of these claims.

17 Appellant respectfully requests that the Board review the coupon filtering paradigm
18 described by Williams and the coupon filtering paradigm disclosed and claimed by appellant.
19 Appellant believes the two coupon filtering paradigms are clearly different and that appellant's
20 paradigm, as claimed, is not obvious in view of Williams or any other cited art. While this
21 difference is subtle, it nonetheless exists, and there is no evidence that one of ordinary skill in the art
22 would have been lead to modify the coupon filtering paradigm disclosed by Williams to achieve the
23 coupon filtering paradigm described and claimed by appellant.

24 Essentially, during a setup mode Williams' coupon filtering paradigm asks "*what does this*
25 *user like?*" In contrast, appellant's invention asks "*for what specific products or services does this*
26 *user want to receive coupons?*" The questions are not identical, nor will the coupons saved by an
27 electronic coupon according to each paradigm be identical. Williams' paradigm can be **overly broad**
28 in the variety of coupons provided a user compared to appellant's paradigm. Williams'
29 entertainment network will deluge users with all manner of coupons having a real or tangential
30 relationship with the user's preference profile. In contrast, users of appellant's have complete
31 control over the coupons they receive, because the user is able to specifically identify products or

1 services from a menu presented in the setup mode, such that they will receive *only* coupons for
2 products and services they have specifically selected. Consider automobile tires, a necessary but
3 relatively infrequent purchase for car owners . Assuming that Williams' entertainment network can
4 identify specific users as car owners (which might require asking if the user is a car owner in a
5 survey or when establishing a profile), Williams' coupon filtering paradigm cannot determine *which*
6 car owners are interested in purchasing tires at any given time. Thus, according to Williams' coupon
7 filtering paradigm, *all* users who are car owners will receive coupons for automobile tires at all times
8 such coupons are available. Many of Williams' users that are car owners will not *want* such
9 coupons, because at any given time, most car owners do not need to replace their tires. According to
10 appellant's coupon filtering paradigm, car owners who *need* automobile tires (and who are users of
11 appellant's electronic coupon) can access the menu of products and services to select automobile
12 tires as a product for which they should receive coupons, and thereby ensure that their electronic
13 coupon will save coupons for automobile tires, until the user affirmatively de-selects automobile
14 tires from the menu of products and services available in the set-up mode. 'Williams' paradigm can
15 also be *overly narrow* as compared to appellant's paradigm, because clearly, a user may sometimes
16 wish to receive coupons that are completely unrelated to their own preferences. Furthermore,
17 Williams' coupon filtering paradigm will not be very effective in providing coupons for gifts
18 selected to match the personal preferences of the *recipient*, as opposed to the giver. In contrast,
19 appellant's coupon filtering paradigm enables the user appellant's electronic coupon to select *any*
20 good or service in the menu displayed in the setup mode to ensure that the electronic coupon will
21 store coupons related to the selected good or service, *regardless* of any relationship that good or
22 service may have to a personal preference of the user. This enables a user of appellant's electronic
23 coupon to selectively receive coupons for products or services he or she intends to give as gifts, even
24 when such gifts are unrelated to the user's personal preferences. The coupon filtering paradigm
25 disclosed and claimed by appellant is therefore clearly different than that disclosed by Williams and
26 provides a very different result and functionality.

27 In the Final Office action dated November 18, 2004, the Examiner asserts Williams discloses
28 that the user indicates a desire for products and services, to generate a preference profile, citing
29 column 6, lines 13-33 of Williams. Appellant agrees that Williams discloses that a user's preference
30 profile can be generated to include many different personal preferences of the user, including
31 whether a user enjoy sports, what type of sports the user enjoys, whether the user enjoys outdoor
32

1 activities, what type of television programming the user enjoys, the user's native language, the user's
2 geographical location, and the types of food enjoyed by a user (Column 6, lines 13-24 of Williams).
3 Certainly some of those preferences *could relate* to a preference for a particular type of good or
4 service, but can also completely fail to indicate specific goods or services for which a user would
5 like to receive coupons. Clearly, such personal preferences are related to the question of "*what does*
6 *this user like?*" and not the question of "*for what specific products or services does this user want to*
7 *receive coupons?*" in appellant's claims. This point will become particularly clear in examining the
8 techniques disclosed by Williams for generating preference profiles. Every technique described by
9 Williams related to generating a preference profile is based on the question "*what does this user*
10 *like?*" Williams does not teach or suggest determining "*specific products or services for which this*
11 *user wants to receive coupons.*"

12 Williams teaches that preference profiles can be generated by surreptitiously tracking the
13 type of entertainment the user consumes (see column 2, lines 5-6). Clearly, generating a preference
14 profile by tracking a user's viewing habits is not equivalent to "*displaying a menu of products and*
15 *services to a user in a set-up mode, such that user selection of a product or service specifically*
16 *indicates that the user desires to have coupons corresponding to the product or service selected to*
17 *be stored by the electronic coupon.*" Tracking a user's viewing habits is an attempt to answer the
18 question "*what TV programming does this user like?*" Once that question has been answered,
19 Williams' entertainment network can attempt to match particular products or services related to the
20 selected kinds of programming in the profile for a particular user, based on the user's viewing
21 interests. However, tracking a user's viewing habits is not equivalent to providing a menu of goods
22 and services to a user, so the user can with specificity identify the goods and services for which the
23 user wants coupons stored on the electronic coupon.

24 Williams also teaches that preference profiles can be generated using user surveys (see
25 column 2, lines 7-9). Generating a preference profile by having a user complete a survey for an
26 entertainment network cannot logically be equivalent to "*displaying a menu of products and services*
27 *to a user in a set-up mode, such that user selection of a product or service specifically indicates that*
28 *the user desires to have coupons corresponding to the product or service selected to be stored by the*
29 *electronic coupon,*" unless the survey presents a menu of product and services *so that the user can*
30 *select products and services for which coupons are to be stored.* Williams does not teach or suggest
31 that the entertainment survey includes such a menu.

1 Another technique described by Williams for generating a preference profile is to have users
2 disclose a preference as part of a registration process or some promotion (see column 6, lines 5-8).
3 Generating a preference profile by having a user disclose entertainment preferences during
4 registration with an entertainment network or during a promotion offered by an entertainment
5 network cannot logically be viewed equivalent to "*displaying a menu of products and services to a*
6 *user in a set-up mode, such that user selection of a product or service specifically indicates that the*
7 *user desires to have coupons corresponding to the product or service selected to be stored by the*
8 *electronic coupon,*" unless the registration or promotion includes such menu. Again, Williams does
9 not teach or suggest that such is the case.

10 It should be apparent that generating a preference profile as described by Williams (by
11 tracking a users viewing habits, by answering a survey offered by an entertainment network, or by
12 completing a registration process with an entertainment network) is not equivalent to displaying a
13 menu of products or services in a setup mode, to enable a user to select a specific product or service
14 from the menu, *specifically* for the purpose of *enabling the user* to control the types of coupons that
15 will be stored in an electronic coupon.

16 It appears that the Examiner may have cited Levitan because Williams does not explicitly
17 teach a menu, whereas Levitan explicitly refers to a menu which enables a user to select
18 programming content. Appellant respectfully submits that a combination of Levitan's personal
19 channel menu and Williams' coupon filtering paradigm would not achieve the coupon filtering
20 paradigm disclosed and claimed by appellant. It is important to recognize that the content displayed
21 in Levitan's personal channel menu includes content that has been filtered according to a viewer's
22 personal profile information (see column 1, lines 44-54; column 2, lines 60-67; and column 4,
23 lines 14-35). Basically, during a setup mode a personal profile of each viewer is developed, and
24 Levitan's system filters programming content so that only programming content related to the
25 viewer's personal profile is displayed in the viewer's personal channel menu. This function is very
26 similar to Williams' coupon filtering paradigm, in that during a setup mode, the following question
27 is asked "*what does this user like?*" If Williams' entertainment network was modified to present a
28 menu of coupons filtered according to a user's preference profile, to enable the user to select
29 content/coupons that had been filtered according to that user's preference profile, such a
30 modification/combination would not result in a setup mode in which a menu of products or services
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1 are displayed to a user, enabling the user to control the types of coupons corresponding to selected
2 goods or services that will be stored on an electronic coupon.

3 Even if the references are combined in the manner suggested by the Examiner, the result
4 achieved is thus not equivalent to the recitation of independent Claims 1, 13, 24, 27, 29, and 31,
5 because the cited art does not teach or suggest displaying a menu of products or services to a user in
6 a set-up mode for the purpose of enabling the user to control the types of coupons that will be stored
7 in an electronic coupon. In Williams' system (and Levitan's system), a user simply indicates what
8 the user likes. In appellant's claims, what a user *likes* is irrelevant, because the user specifically
9 indicates the goods and services *for which coupons are desired*. Clearly, these two techniques are
10 not identical or equivalent. Each of the independent claims is thus patentable over the combination
11 of art cited by the Examiner. Because dependent claims are patentable for at least the same reasons
12 as the claims from which they depend, Claims 2-12, 14-23, and 25 are also patentable for at least
13 these same reasons. Accordingly, the rejection of Claims 1-25, 27, 29, and 31 as being obvious over
14 the cited art should be withdrawn.

15 Rejection of Claims 2, 24, 25 and 28 under 35 U.S.C. § 103

16 The Examiner has rejected Claims 2, 24, and 25 under 35 U.S.C. § 103(a) as being
17 unpatentable over Mankovitz et al. (U.S. Patent No. 5,523,794), in view of Small (U.S. Patent
18 No. 5,808,689), further in view of Terrill et al. (U.S. Patent No. 6,052,755), further in view of
19 Levitan (U.S. Patent No. 5,534,911), and further in view of Williams et al. (U.S. Patent
20 No. 6,075,971). The Examiner concludes that an artisan of ordinary skill would have been led to
21 combine and modify the teachings of these references to achieve an equivalent to appellant's claim
22 in order to provide a more versatile system and method for distributing electronic coupons, and that
23 because Mankovitz discloses a portable coupon as *an integrated decoder*, the above combination of
24 references would achieve a portable electronic coupon including an integrated decoder.

25 The Examiner has similarly rejected Claim 28 under 35 U.S.C. § 103(a) as being
26 unpatentable over Mankovitz et al. (U.S. Patent No. 5,523,794), in view of Small (U.S. Patent
27 No. 5,808,689). The Examiner indicates that Mankovitz discloses a portable coupon including keys,
28 memory, a controller and a display, *and an integrated decoder*; and that Small discloses encoding
29 and decoding data using the horizontal overscan portion of a video signal. The Examiner appears to
30 conclude that an artisan of ordinary skill would have been led to combine and modify these
31

1 references to achieve an equivalent to appellant's claim in order to provide a more versatile system
2 and method for distributing electronic coupons.

3 Because Claims 2, 24, 25, and 28 each recite a decoder (i.e., the component that extracts
4 coupon data from the horizontal overscan portion of the video signal) that is part of the electronic
5 coupon, the patentability of such claims can be analyzed together. Claims 2 and 24 recite that the
6 decoder and other elements are encompassed by a common housing that it is sufficiently portable to
7 enable the electronic coupon to be readily transportable to a retailer, so that the coupons stored
8 therein can be redeemed. Such a portable electronic coupon is disclosed in appellant's specification
9 at page 10, lines 3-4, which describes that appellant's electronic coupon displays a coupon that is
10 read by a bar code scanner in a supermarket. Claim 28 recites the step of taking the electronic
11 coupon that includes the decoder to a retailer to redeem a coupon stored therein.

12 Appellant has previously argued that Mankovitz discloses an electronic coupon 10 that
13 couples to an *external* controller 12 (see FIGURE 1a of Mankovitz), which carries out the decoding
14 function, i.e., the external controller extracts coupon data from the vertical blanking interval of a
15 video signal. The Examiner has responded that because the controller/decoder disclosed by
16 Mankovitz includes a moiety connector 18 configured to receive a moiety connector 20 on the
17 electronic coupon, the controller can be considered to be encompassed in the same housing as the
18 electronic coupon. Respectfully, this conclusion does not appear to be well reasoned.

19 The Examiner is correct that Mankovitz discloses several different types of connections that
20 can be used to enable the decoder/controller to transfer coupon data to the electronic coupon. In
21 particular, Mankovitz discloses that the portable data coupon incorporates a receiver for the re-
22 transmitted encoded data (that is, the portable data coupon includes a receiver configured to receive
23 coupon data extracted from the vertical blanking interval of the video signal by the
24 controller/decoder). If, as the Examiner asserts, the decoder/controller is part of the electronic
25 coupon, there would be no need to transfer data between the decoder/controller and the electronic
26 coupon. The very fact that Mankovitz teaches that the *data must be transferred* from the
27 decoder/controller to the electronic coupon should indicate to one of ordinary skill in the art that the
28 decoder/controller and the electronic coupon are not contained in a common housing. The further
29 assertion (office action dated November 18, 2004, page 8, second paragraph) by the Examiner that
30 the decoder/controller coupled with the electronic coupon (referred to by the Examiner as the
31 system) is taken to a retailer to enable a coupon stored in the electronic coupon to be redeemed is
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1 entirely unsupported by Mankovitz's disclosure. There is no evidence that Mankovitz teaches or
2 suggests taking the *decoder/controller* to a retailer, when taking the *electronic coupon* to the
3 retailer.

4 The cited art clearly teaches that the decoder (i.e., the controller) is a separate component,
5 which is not integral to or part of the electronic coupon. Mankovitz specifically discloses that the
6 electronic coupon includes a display 22, input keys 24, 26, 28, 30, and 62, beeper 44, IR detector 16,
7 connector 20, IR emitter 32, processor 35, clock 42, RAM 36, ROM 46, and driver 40.
8 Controller 12 is clearly described as a separate component, *which is not part of the electronic*
9 *coupon*. Simply because the electronic coupon described by Mankovitz can couple to the controller
10 to receive data does not make the controller an integral part of the electronic coupon. In an attempt
11 to clarify this distinction, appellant employed language reciting that the elements of the electronic
12 coupon (including the decoder) are encompassed in a common housing. There is simply no
13 reasonable basis for asserting that the housing of Mankovitz's controller is the same housing on
14 Mankovitz's electronic coupon. Clearly, since Mankovitz's controller is removably coupled to
15 Mankovitz's electronic coupon via a hard wire connection, Mankovitz's controller cannot be
16 enclosed in the same housing as Mankovitz's electronic coupon. Two separate housings, enclosing
17 separate components (i.e., the controller, and the electronic coupon), are simply not a common
18 housing. The cited art, alone or in combination, therefore does not teach or suggest including a
19 decoder within an electronic coupon, as opposed to implementing the decoder in a separate housing,
20 as a separate device. This distinction is not merely a matter of design, since inclusion of a decoder
21 in the electronic coupon substantially adds to the functionality of the electronic coupon claimed by
22 appellant, compared to the electronic coupon of Mankovitz.

23 Claims 2, 24, and 25 also recite enabling a user to select at least one coupon category from a
24 menu of products or services, and thus, these claims also distinguish over the cited art for the reasons
25 discussed above with respect to the rejection of Claims 1-25, 27, 29, and 31.

26 Rejection of Claims 9, 19, 29 and 31 under 35 U.S.C. § 103

27 The Examiner has rejected Claims 9, 19, 29, and 31 under 35 U.S.C. § 103(a) as being
28 unpatentable over Mankovitz et al. (U.S. Patent No. 5,523,794), in view of Small (U.S. Patent
29 No. 5,808,689), further in view of Terrill et al. (U.S. Patent No. 6,052,755), further in view of
30 Levitan (U.S. Patent No. 5,534,911), and further in view of Williams et al. (U.S. Patent
31 No. 6,075,971). The Examiner indicates that Williams discloses a set-up mode, which enables users
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1 to complete preference profiles that can be used to filter coupons, and a storage mode, wherein
2 filtered coupons are stored for later redemption. The Examiner asserts that Williams thus also
3 encompasses a redeem mode. The Examiner further notes that Levitan discloses a personal menu (a
4 final list of user desires), which the Examiner apparently concludes is equivalent to the menu of
5 stored coupons accessible by a user in appellant's redeem mode. The Examiner further asserts that
6 the use of a mode key is notoriously well-known in the art, and that it would have been obvious to
7 one of ordinary skill in the art at the time of the invention to modify the electronic coupon disclosed
8 by Mankovitz to achieve an electronic coupon in which a mode key enables the user to select a setup
9 mode, a storage mode, and a redeem mode.

10 Claims 9, 19, 29, and 31 each recite that the user must manipulate a key to place the
11 electronic coupon in a *storage mode*, wherein coupons are received and filtered according to
12 selections made by the user in the set-up mode. Significantly, appellant's electronic coupon will not
13 analyze coupon data and save coupons corresponding to the products and services selected by the
14 user in the setup mode unless a user has manipulated the key to place the electronic coupon in the
15 *storage mode*. This functionally is clearly patentably distinguished over the logic controlling the
16 function of Mankovitz's portable data coupon.

17 It appears that as long as Mankovitz's portable data coupon is energized and coupled to a
18 decoder/controller to receive coupon data, coupon data will always be stored in a first-in, first-out
19 memory buffer. As disclosed by Mankovitz, the portable data coupon includes a memory buffer and
20 a permanent memory. All incoming coupon data are initially stored in the memory buffer.
21 Whenever the capacity of the memory buffer is exceeded, the oldest coupon data are deleted to make
22 room for the newest coupon data. By manipulating a READ key, a user can review the contents of
23 the buffer, and then use a SAVE key to move selected coupons from the buffer to the permanent
24 memory, to prevent a particularly desired coupon from being overwritten in the buffer. The READ
25 key is also used by Mankovitz to access any coupon data stored in either the buffer or permanent
26 memory, to facilitate redemption or deletion of a specific coupon. If a particular coupon is no longer
27 desired, a CANCEL key can be manipulated to delete coupon data. If a particular coupon is to be
28 redeemed, a SEND key can be manipulated (it appears that in some embodiments, coupon data
29 selected using the READ key are displayed as a UPC code, enabling redemption without use of the
30 SEND key).

1 Significantly, Mankovitz does not teach or suggest that a user first select a key to enable data
2 *to be stored* in the memory buffer. If Mankovitz's portable data coupon is modified to incorporate
3 the coupon filtering paradigm disclosed by Williams, it is not clear why an artisan of ordinary skill
4 would be led by the combined disclosure of these references to require a user to manipulate a key in
5 order to enable a modified portable data coupon to analyze coupon data to determine whether the
6 coupon data should be stored or not stored. Based on the functionality of Mankovitz's unmodified
7 portable data coupon, there would appear to be no requirement or obvious advantage to requiring
8 manipulation of such a key to enable incoming coupon data to be analyzed. Moreover, a
9 modification of Mankovitz's portable data coupon to require a user to manipulate a key to
10 affirmatively select a *storage mode* in order to enable the portable data coupon to analyze incoming
11 coupon data (to determine if such coupon data ought to be stored by the portable data coupon) does
12 not appear to be taught or suggested by the cited art.

13 The Examiner has asserted (final office action dated November 18, 2004, page 9, paragraph
14 3) that because Williams discloses a coupon filtering paradigm, Williams discloses a key operative
15 to select a storage mode in which the controller analyzes extracted coupon data and saves each
16 coupon corresponding to the products and services selected by the user in the set-up mode. While
17 Williams does disclose a coupon filtering paradigm (which, as discussed above, is distinguishable
18 from the coupon filtering paradigm described and claimed by appellant), there does not appear to be
19 any basis to conclude that a keystroke is required to enable such coupon filtering to occur. Williams
20 does not teach that coupon filtering is only enabled after a user affirmatively manipulates a key to
21 switch such coupon filtering on.

22 Thus, enabling Mankovitz's portable data coupon to filter incoming coupon data according to
23 the coupon filtering paradigm disclosed by Williams does not require revising the operation of the
24 READ key, SAVE key, and SEND key disclosed by Mankovitz. Other than the application of
25 hindsight in order to achieve an equivalent to appellant's claims, there appears to be no reason to
26 further modify Mankovitz's portable data coupon to exhibit the same control logic (a state machine
27 exhibiting three functionally distinguishable states, a redeem mode, a setup mode, a storage mode)
28 disclosed and claimed by appellant.

29 By comparison, in appellant's Claims 9, 19, 29, and 31, the user manipulates a key to place
30 the electronic coupon in a storage mode. When in the storage mode, the controller analyzes
31 extracted coupon data and saves each coupon corresponding to the products and services selected by
32

1 the user in the setup mode. Thus, in appellant's claimed electronic coupon, coupons are only filtered
2 and saved when the user manipulates a key to change the state of the electronic coupon from one of
3 the other modes (i.e., from the set up mode or redeem mode) to the storage mode. The cited art,
4 alone or in combination, therefore does not teach or suggest an electronic coupon that includes a
5 single mode key enabling a user to selectively access a set-up mode, a storage mode, and a redeem
6 mode.

7 CONCLUSION

8
9 The art cited by the Examiner in rejecting Claims 1-25, 27, 29, and 31 as obvious does not in
10 combination disclose or suggest the recitation of these claims. Specifically, the cited art fails to
11 teach any equivalent to displaying a menu of products or services during a start up mode to enable
12 the user to select goods and services so that corresponding coupons are stored by the electronic
13 coupon. The coupon filtering method disclosed by Williams is not equivalent to appellant's recited
14 method, because Williams does not teach or suggest the step of displaying a *menu of products or*
15 *services* to a user in a start up mode specifically for the purpose of enabling the user to exert control
16 over the types of coupons are stored by all the electronic coupon. According to Williams' coupon
17 filtering paradigm, it is a third party, and not the user, who exerts control over the types of coupons
18 that are stored.

19 The art cited by the Examiner in rejecting Claims 2, 24, 25 and 28 as unpatentable under
20 35 U.S.C. § 103 also does not in combination disclose the invention defined by these claims.
21 Specifically, the cited art fails to teach an electronic coupon that includes an integral decoder.

22 The art cited by the Examiner in rejecting Claims 9, 19, 29, and 31 as unpatentable under
23 35 U.S.C. § 103 does not in combination disclose the recitation of these claims. Specifically, the
24 cited art fails to teach or suggest an equivalent to appellant's recited coupon filtering, and fails to
25 teach or suggest requiring manipulation of a key to place the electronic coupon in a storage mode.

26 //

27 //

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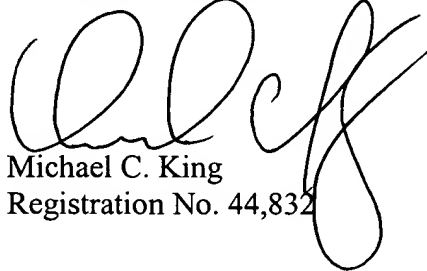
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1 Appellant therefore respectfully requests that the Board of Patent Appeals and Interferences
2 overrule the Examiner's rejection of the claims and require that the Examiner pass this case to issue
3 without further delay.

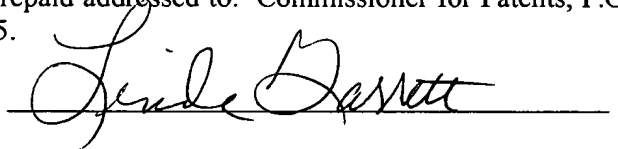
4
5 Respectfully submitted,

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8 Michael C. King
9 Registration No. 44,832

10 MCK/RMA:lrg

11 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
12 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O.
13 Box 1450, Alexandria, VA 22313-1450, on June 8, 2005.

14 Date: June 8, 2005

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1
2 APPENDIX

3 Claims on Appeal:

4 1. A system for selectively storing and selectively displaying coupons defined by coupon
5 data extracted from a horizontal overscan portion of a video signal, the system comprising:

6 a decoder configured to receive a video signal during a transmission session and to extract
7 coupon data from the horizontal overscan portion of the video signal producing extracted coupon
8 data, the extracted coupon data defining a plurality of coupons relating to different products and
9 services; and
10

11 an electronic coupon configured to selectively store and to selectively display coupons
12 defined by the extracted coupon data, the electronic coupon comprising:

13 a display configured to selectively display coupons defined by the extracted
14 coupon data;

15 a plurality of control keys configured to selectively respond to actuation by a
16 user;

17 a non-volatile memory configured to selectively store coupons defined by the
18 extracted coupon data, and
19

20 a controller configured to process the extracted coupon data produced by the
21 decoder, the controller being logically coupled to the display, to the plurality of control keys, and to
22 the non-volatile memory, the controller implementing the following functions:

23 enabling a user to selectively manipulate at least one of the of the
24 plurality of control keys to select a set-up mode prior to the transmission session, the controller
25 responding to the selection of the set-up mode by causing a menu including a plurality of different
26 products and services to be presented to the user on the display;

27 enabling a user to manipulate at least one of the of the plurality of
28 control keys to select at least one of the different products and services displayed in the menu,
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1 selection of a product or a service indicating that the user desires extracted coupon data
2 corresponding to the product or the service selected to be stored in the electronic coupon; and
3
4 automatically analyzing the extracted coupon data produced by the
5 decoder, such that only coupons defined by the extracted coupon data that correspond to the at least
6 one of the different products and services selected by the user in the set-up mode are automatically
7 stored in the non-volatile memory, and each coupon defined by the extracted coupon data that does
8 not correspond to the at least one of the different products and services selected by the user in the
9 set-up mode is automatically discarded.
10

11 2. The system of Claim 1, wherein the decoder is an integrated part of the electronic coupon,
12 such that the decoder, the display, the at least one control key, the non-volatile memory, and the
13 controller are encompassed in a common housing, the common housing being sufficiently portable
14 that the electronic coupon is transportable to a retailer so that coupons stored thereon can be
15 redeemed.
16

17 3. The system of Claim 1, wherein the electronic coupon further comprises a Liquid Crystal
18 Display (LCD) for displaying a selected coupon.

19 4. The system of Claim 3, wherein the selected coupon is displayed as a Universal Product
20 Code bar code.

21 5. The system of Claim 4, wherein the Universal Product Code can be read by a bar code
22 scanner.
23

24 6. The system of Claim 1, wherein the transmission session comprises a broadcast of a
25 television program.

26 7. The system of Claim 6, wherein the television program comprises a television
27 commercial.

28 8. The system of Claim 1, wherein when the non-volatile memory in the electronic coupon is
29 full, no additional extracted coupon data will be automatically stored until at least some previously
30 extracted coupon data are deleted.
31

1 9. The system of Claim 1, wherein at least one of the of the plurality of control keys
2 comprises a mode key, the mode key being operative to select between a storage mode and a redeem
3 mode, such that when in the storage mode, the controller analyzes extracted coupon data and saves
4 each coupon corresponding to the products and the services selected by the user in the set-up mode,
5 and when in the redeem mode, the controller causes a menu of each coupon stored in the electronic
6 coupon to be presented to the user on the display.
7

8 10. The system of Claim 9, wherein the mode key is further operative to select the set-up
9 mode.
10

11 11. The system of Claim 1, wherein the non-volatile memory comprises magnetic media.

12 12. The system of Claim 1, wherein the non-volatile memory comprises an electrical circuit.

13 13. A method for storing coupon data extracted from the horizontal overscan portion of a
14 video signal in an electronic coupon, the method comprising the steps of:

15 providing an electronic coupon configured to selectively store coupons defined by coupon
16 data extracted from the horizontal overscan portion of the video signal during a transmission session,
17 the electronic coupon comprising a controller configured to analyze and manipulate the extracted
18 coupon data;
19

20 before the transmission session, enabling a user to select a set-up mode available in the
21 electronic coupon by manipulating a key on the electronic coupon, the controller responding to
22 selection of the set-up mode by displaying a menu including a plurality of different products and
23 services;
24

25 enabling the user to select at least one of the different products and services, selection of a
26 product or a service indicating that the user desires extracted coupon data corresponding to the
27 product or the service selected to be stored in the electronic coupon;

28 receiving the video signal during a transmission session;

29 extracting coupon data from the horizontal overscan portion of the video signal; and

30 using the controller for automatically performing the steps of:
31
32

1 determining a product or a service corresponding to each coupon defined by the
2 extracted coupon data;

3 storing each coupon defined by the extracted coupon data corresponding to a product
4 or a service selected by the user, in the electronic coupon; and

5 discarding each coupon defined by the extracted coupon data that does not correspond
6 to a product or a service selected by the user.
7

8 14. The method of Claim 13, wherein the transmission session comprises a broadcast of a
9 television program.

10 15. The method of Claim 13, wherein the transmission session comprises a play-back of a
11 video taped program.

12 16. The method of Claim 13, wherein the step of storing each coupon defined by the
13 extracted coupon data corresponding to a product or a service selected by the user comprises the step
14 of storing the coupon in a non-volatile memory in the electronic coupon.
15

16 17. The method of Claim 13, further comprising the step of enabling a user to select a
17 redeem mode available on the electronic coupon by manipulating a key on the electronic coupon, the
18 controller responding to selection of the redeem mode by displaying a menu of stored coupons
19 defined by the extracted coupon data corresponding to a product or a service selected by the user.
20

21 18. The method of Claim 17, further comprising the step of enabling the user to select one of
22 the stored coupons displayed in the menu of stored coupons, the controller responding to selection of
23 one of the stored coupons by displaying the stored coupon.
24

25 19. The method of Claim 13, further comprising the step of enabling the user to select a
26 storage mode available in the electronic coupon by manipulating a key on the electronic coupon, the
27 controller responding to selection of the storage mode by analyzing the extracted coupon data as the
28 data are received by the electronic coupon.

29 20. The method of Claim 18, wherein the coupon displayed comprises a Universal Product
30 Code bar code.
31

1 21. The method of Claim 20, wherein the coupon displayed can be read by a bar code
2 scanner.
3

4 22. The method of Claim 16, wherein the non-volatile memory comprises magnetic media.

5 23. The method of Claim 16, wherein the non-volatile memory comprises an electrical
6 circuit.

7 24. An electronic coupon for decoding and selectively storing coupon data that are encoded
8 in a horizontal overscan portion of a video signal, the electronic coupon comprising:

9 a decoder configured to receive the video signal, said decoder processing video signals thus
10 received to decode coupon data that are encoded in the horizontal overscan portion of the video
11 signal, producing decoded coupon data, the decoded coupon data defining at least one coupon;

12 a display configured to selectively display coupons defined by the decoded coupon data;

13 a plurality of control keys configured to be selectively controlled by a user;

14 a memory in which selected coupons defined by the coupon data decoded by the decoder can
15 be stored; and
16

17 a processor configured to process the decoded coupon data produced by the decoder, the
18 processor being logically coupled to the display, to the plurality of control keys, and to the memory,
19 the processor implementing the following functions:
20

21 enabling a user to manipulate at least one of the of the plurality of control keys to
22 select a set-up mode prior to a transmission session, the controller responding to the selection of the
23 set-up mode by causing a menu including a plurality of different products and services to be
24 presented to the user on the display, selection of a product or a service indicating that the user
25 desires decoded coupon data corresponding to the product or the service selected to be stored in the
26 electronic coupon;
27

28 enabling a user to manipulate at least one of the of the plurality of control keys to
29 select at least one of the different products and services displayed in the menu;
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1 automatically analyzing the decoded coupon data produced by the decoder, such that
2 only coupons defined by the decoded coupon data that correspond to a product or a service selected
3 by the user in the set-up mode are automatically stored in the memory, and each coupon defined by
4 the decoded coupon data that does not correspond to a product or a service selected by the user in the
5 set-up mode is automatically discarded, the decoder, the display, the plurality of control keys, the
6 memory, and the processor being encompassed in a common housing, the common housing being
7 sufficiently portable that the electronic coupon is transportable to a retailer, where coupons stored
8 therein are redeemable.
9

10
11 25. The system of Claim 24, wherein the memory comprises magnetic media.

12 27. A system for decoding and selectively storing coupon data that are encoded in a
13 horizontal overscan portion of a video signal, the system comprising:

14 a decoder adapted to receive the video signal, said decoder processing video signals thus
15 received to decode coupon data that are encoded in the horizontal overscan portion of the video
16 signal the decoded coupon data defining at least one coupon;

17 an electronic coupon comprising:

18 a receiver adapted to receive decoded coupon data from said decoder;

19 a memory for use in storing selected coupon data decoded by the decoder;

20 a display enabling a user to view the coupon data decoded by the decoder;

21 a plurality of control keys to selectively control a display of coupon data decoded by
22 the decoder; and
23

24 a processor logically coupled to said receiver, to said memory, to said display, and to
25 said plurality of control keys, said processor enabling a user to selectively manipulate the decoded
26 coupon data received from the decoder by the receiver, said processor enabling a user to manipulate
27 at least one of said plurality of control keys to select a set-up mode, such that when the set-up mode
28 is selected, a user is presented with a menu comprising a plurality of different products and services
29 that a user can select by manipulating at least one of said plurality of control keys, so that said
30
31

1 processor automatically evaluates any decoded coupon data received by said receiver, such that
2 decoded coupon data that correspond to a selected product or service are automatically stored in said
3 memory, and decoded coupon data that do not correspond to a selected product or service are
4 automatically not stored in said memory, selection of a product or service indicating that the user
5 desires decoded coupon data corresponding to the product or the service selected to be stored in the
6 electronic coupon.
7

8 28. A method for delivering and storing coupon data for an electronic coupon using the
9 horizontal overscan portion of a video signal, the method comprising the steps of:
10

11 providing an electronic coupon including a decoder configured to extract coupon data from
12 the horizontal overscan portion of the video signal, such that the decoder and other functional
13 components of the electronic coupon are encompassed in a common housing that is readily taken to
14 a retailer to redeem a coupon stored in the electronic coupon;

15 receiving the video signal at the electronic coupon during a transmission session;

16 extracting coupon data from the horizontal overscan portion of a video signal using the
17 decoder in the electronic coupon;

18 storing the coupon data extracted by the decoder in the electronic coupon,

19 taking the electronic coupon that includes the decoder to a retailer, to redeem a coupon stored
20 in the electronic coupon; and
21

22 displaying the electronic coupon to a retailer to redeem the electronic coupon.
23

24 29. A method for delivering and selectively storing coupon data using the horizontal
25 overscan portion of a video signal, the method comprising the steps of:

26 providing an electronic coupon comprising a plurality of keys configured to receive input
27 from a user, the plurality of keys including a mode key operative to enable a user to toggle between a
28 start up mode and a storage mode;
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1 actuating the mode key to selectively enter the start up mode, such that in response to
2 selection of the start up mode, the electronic coupon automatically displays a menu including a
3 plurality of products and services;
4

5 enabling a user to select at least one product or service from the menu, selection of a product
6 or a service indicating that the user desires coupon data corresponding to the product or the service
7 selected to be stored in the electronic coupon;

8 actuating the mode key to selectively enter the storage mode, such that in response to
9 selection of the storage mode, the electronic coupon is enabled to automatically evaluate any coupon
10 data extracted from the horizontal overscan portion of a video signal to determine if such coupon
11 data correspond to a product or a service selected in the start up mode;
12

13 receiving the video signal;

14 extracting coupon data from the horizontal overscan portion of the video signal;

15 automatically evaluating the extracted coupon data with the electronic coupon; and

16 if the extracted coupon data matches a selected product or service, then automatically storing
17 the extracted coupon data, and otherwise, not storing the extracted coupon data.
18

19 31. A system for decoding and storing coupon data that are encoded in a horizontal overscan
20 portion of a video signal, the system comprising:

21 a decoder adapted to receive the video signal, the decoder processing video signals thus
22 received to extract coupon data that are encoded in the horizontal overscan portion of the video
23 signal, the extracted coupon data defining a plurality of coupons, at least some of the coupons
24 corresponding to different products and services;
25

26 an electronic coupon comprising:

27 a receiver configured to receive the plurality of coupons extracted by the decoder;

28 a memory configured to selectively store coupons received by the electronic
29 controller;

30 a display enabling a user to selectively view a coupon stored in the memory;
31
32

1 a plurality of control keys configured to receive an input from a user, including a mode
2 key enabling a user to selectively toggle between a set-up mode, a storage mode, and a redeem mode;
3 and
4

5 a processor logically coupled to the receiver, to the memory, to the display, and to the
6 plurality of control keys, the processor implementing at least the following functions:

7 responding to a user using the mode key to select the set-up mode by displaying a
8 menu including a plurality of different products and services to the user on the display;
9

10 enabling a user to manipulate at least one of the plurality of control keys to
11 select at least one of the different products and services displayed in the menu in the set-up mode,
12 selection of a product or service indicating that the user desires coupons extracted by the decoder
13 that correspond to the product or the service selected to be stored in the electronic coupon;

14 responding to a user using the mode key to select the storage mode by
15 automatically analyzing each coupon defined by coupon data extracted from a video signal by the
16 decoder and received by the electronic coupon, such that only coupons that correspond to a product
17 or a service selected by the user in the set-up mode are automatically stored in the memory, and each
18 coupon that does not correspond to a product or a service selected by the user in the set-up mode is
19 automatically discarded; and
20

21 responding to a user manipulating the mode key to select the redeem mode by
22 displaying a menu including each coupon stored in the memory.
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